

Application Serial No. 09/898,068
Decision on Petition



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In re Application of: Takeshi Kuribayashi et al.
Application No.: 09/881,672
Filed: June 18, 2001
For: ELECTRONIC COMPONENT AND
MOUNTING METHOD AND APPARATUS
THEREOF

DECISION ON PETITION

This is a decision on the petition filed on July 14, 2003 requesting reconsideration and withdrawal of the restriction requirement under 37 C.F.R. § 1.144.

The petition is **DENIED**.

Petitioner asserts that the Requirement for Restriction of February 20, 2002, is improper because there is no burden on the examiner to examine the restricted claims as they are identical to the claims in the parent application 09/319779. The petitioner timely traversed the restriction requirement in the response of March 15, 2002. The requirement was made final in the office action of June 6, 2002. Then, petitioner again traversed the restriction requirement in the Request for Reconsideration filed June 27, 2002.

A review of the action mailed December 18, 2002, indicates that the following restriction requirement was made:

- Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 26-36, drawn to a product, classified in class 174, subclass 52.4.
 - II. Claims 37-44, drawn to a method, classified in class 29, subclass 825
 - III. Claims 45-47, drawn to an apparatus, classified in class 29, subclass 729

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as a mounting the product on the board, then checking the reference marks to be sure the product was correctly mounted and reworking the product if it was not correctly mounted.

Inventions II and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP 806.05(e)). In this case the method can be exercised by hand and the marks read by a human eye.

Inventions III and I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) the product as claimed can be made by another and materially different apparatus (MPEP 806.05(g)). In this case the product can be made by hand.

Petitioner submits that the Requirement for Restriction of February 20, 2002, is improper because, "there is no serious burden because the search and examination of claims 26-47 was previously conducted in the parent application (i.e. Serial No. 09/319,779). In particular, claims 26-47 correspond to claims 46-51, 53, and 55-72, respectively, and the merits of these claims were examined in the parent application." The parent application 09/319779 was filed as a national stage of a PCT application under 371. Therefore, restriction practice in that case is governed by, the unity of invention standard, a standard different from the U.S. restriction practice under 35 USC 121 which applies to the current application.

In the Office action of June 06, 2002, the examiner deemed this argument unpersuasive because, "the claims in the present application are not identical in scope to the claims in the parent application." In the response filed November 06, 2002, petitioner traversed the examiner's statement, arguing that, "the claims are identical to claims that were considered in the parent application."

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A careful review of the record indicates that while the claims of the present application and the parent application are similar, they are not identical. Specifically, claim 26 has the limitation "located on a surface of the electronic component" which is not present in claim 46. Other differences also exist.

In parent application 09/319779, an original restriction requirement was made similar to the restriction requirement in the present application. The restriction was subsequently withdrawn because case 09/319779 was filed as a national stage of a PCT.

The issue at hand is that the propriety of the restriction requirement does not depend on whether claims 26-47 are identical to claims 46-51, 53 and 55-72, and whether or not identical claims were searched and examined in the parent application. The propriety depends on whether the distinctness criteria were properly met and whether burden due to divergent search and different classification or different status in the art (MPEP 808.02) is present. Both of these criteria are properly met in the restriction requirement for the present application.

Petitioner has not argued that the examiner did not show by appropriate explanation separate classification, separate status in the art, or a different field of search. Therefore, the petitioner is not properly rebutting the burden to the examiner. The petitioner there is no burden to the examiner because the claims are identical to those in the parent application. This assertion does not rebut the showing of separate classification, separate status in the art, and a different field of search.

MPEP 811.04 states:

Even though inventions are grouped together in a requirement in a parent application, restriction or election among the inventions may be required in the divisional applications, if proper.

A review of the prosecution history of the instant application reveals that a non-final office action was mailed on December 3, 2003, to which no response has been received. The case is being forwarded to central files to await applicant's response to the office action of December 3, 2003.



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